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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/864,291

05/25/2001

Richard Oko

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12/14/2004

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EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|--------------------------------------|-----------------------------------|--|
| Advisory Action | Application No. 09/864,291 | Applicant(s) OKO ET AL. | |
| | Examiner Chih-Min Kam | Art Unit 1653 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

3 PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires ___ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 10 and 74.

Claim(s) rejected: 8,9,11-15,48,53,60-62,65-67 and 73.

Claim(s) withdrawn from consideration: 1-7,16-47,49-52,54-59,63,64 and 69-72.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: The amendment to the claims does not resolve the current issues under 35 USC 112, first paragraph. In the amendment of November 17, 2004, claims 9, 48, 61, 62 and 73 have been amended; claims 1-7, 16-47, 49-52, 54-59, 63, 64 and 69-72 have been cancelled; and new claims 75-93 have been added. Applicants' response has been fully considered, however, claims 82-92 are rejected under 35 USC 112, first paragraph.

If applicants' amendment were entered, it would have the following response:

1. Claims 82-92 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is not enabling for a polynucleotide comprising a sequence that hybridizes to the sequence of SEQ ID NO:4 or 11 under a cited hybridization condition, wherein a polypeptide encoded by the polynucleotide induces oocyte activation; a gene comprising the polynucleotide, a vector comprising the vector; a host cell comprising the vector, and a method of producing the polypeptide because the specification discloses SEQ ID NO:4 or SEQ ID NO:11 is the coding sequence for bovine or human PT32 protein (SEQ ID NO:5 or 12), it has not identified any polynucleotide that hybridizes to the sequence of SEQ ID NO:4 or 11 and encodes a polypeptide having the activity of inducing oocyte activation. Figures 7A, 7B and 7C merely show the anti-sense RNA of PT-32 coding sequence is used to selectively hybridize with the nucleotide sequence obtained from bull, human, and rat testis, thus, the nucleotide sequences obtained from bull, human, and rat testis are the sequences that hybridize to the complement of SEQ ID NO: 4 or 11 and that encode PT32 from various species. It is not the sequence that hybridizes to SEQ ID NO:4 or 11 encode the functional polypeptide. Therefore, the nucleotide sequence that hybridizes to SEQ ID NO: 4 or SEQ ID NO:11 and encodes a polypeptide that induces oocyte activation is not enabled (see paragraphs 4 and 5 of the Office Action dated 9/2/04).

In response, applicants indicate claim 73 has been amended to include the phrase "hybridize to the complement of the sequence" for each of the identified sequences in the claim, and new claim 82 has been added to define polynucleotides that hybridize to the sequences defined by SEQ ID NO:4 or 11. As one of skill in art would readily realize, both strands may be used to encode a polypeptide either directly or indirectly using standard protocols (page 9 of the response).

Applicant's response have been considered, however, the argument is not found persuasive because SEQ ID NO:4 or 11 is the coding sequence for PT32 protein, and the nucleotide sequence that hybridizes to the sequence of SEQ ID NO:4 or 11 may be used indirectly to identify a nucleotide sequence that encodes a polypeptide having the activity of inducing oocyte activation, it has not been demonstrated that the nucleotide sequence that hybridizes to the sequence of SEQ ID NO:4 or 11 can encode a polypeptide having the activity of inducing oocyte activation.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, the rejection of claims 8-15, 48, 53, 60-62, 65-67 and 73 under 35 USC 112, first paragraph; and the rejection of claims 9 and 48 under 35 USC 112, second paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: The amendment to the claims does not resolve current issues under 35 USC 112, first paragraphs for claims 82-92.

Continuation of 10. Other: See attached Interview Summary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

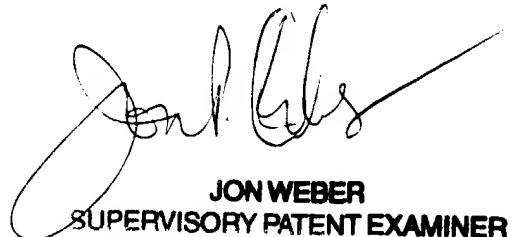
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner

CMK

CMK
December 13, 2004



JON WEBER
SUPERVISORY PATENT EXAMINER